

REMARKS

General:

Claims 1-27 were pending in this application. Claims 1-27 stand rejected. Claim 20 is canceled. Claims 10 is amended as discussed below. Claims 1-9 and 11-27 are pending in this application after the present amendment.

No new matter is added by this amendment.

35 U.S.C. § 102 rejection:

Claims 1-7, 10-15, 18-20, and 23-26 are rejected as anticipated by U.S. Patent No. 6,434,109 (Rollhaus et al.). The rejection is traversed as to the claims now presented.

The office action cites FIG. 13 and col. 11, lines 1-14 of Rollhaus as showing an optical disc with, among other features, a reservoir attached to the substrate and located in proximity to the data storage region for storing a flowable chemical agent and so arranged that the said chemical agent can flow from the reservoir to interact with the data storage medium and permanently interfere with the readability of the data, wherein the chemical agent is retained in the reservoir substantially solely by liquid surface phenomena, and wherein in normal use force associated with the motion tends to overcome the action of the liquid surface phenomena and cause the chemical agent to flow from the reservoir.

The rejection is traversed on the ground that the cited reference does not teach or suggest all the features required by the claims. Specifically, the reference does not teach that the chemical agent is retained in the reservoir by liquid surface phenomena, as recited in claims 1 and 23, or by surface tension, as now recited in claim 10.

The Office action cites to col. 11, lines 1-8 of Rollhaus, but neither there nor anywhere else in Rollhaus is there any mention of how the liquid is retained. The rejection reads into the reference what is first disclosed in the present application. There are other ways of retaining a liquid in an unsealed container. There is nothing in the prior art, without the benefit of impermissible hindsight from the present application, that could have made the use of liquid surface phenomena implicit, or even obvious to the ordinary skilled person. In addressing original claim 20, the Office action states that in Rollhaus "the liquid is retained until the disc spins," but merely assumes, without even attempting to prove, that this implies surface tension as the mechanism effecting the retention.

The rejection is traversed on the ground that the cited reference does not contain an enabling disclosure of the structure recited in applicant's claims.

FIG. 13 shows the reservoir 72 simply as an outline in plan view with a gap in the outline. There is no indication of where the reservoir is located in the perpendicular direction, or how it is constructed. Is it on the label side, or on the reading side? In either case, how is the exposed side of the reservoir closed off, and how is the released solvent guided to a place where it can degrade the optical characteristics of the disc. Is the reservoir somewhere within the disc? Possibly Rollhaus would contend that the embodiment of FIG. 13 could be constructed analogously to the embodiment of FIG. 17, subsequently described. However, the description of FIG. 13 does not refer to FIG. 17 or its description. Also, in the embodiment of FIG. 17 evidently the solvent cannot be retained by liquid surface phenomena (even though "capillary-tube-sized passages" are specified at col. 11, lines 19-20), or the elaborate valve mechanism that is the real subject of FIG. 17 would not be needed. Absent any teaching of how the construction of FIG. 13 **differs** from that of FIG. 17, the construction of FIG. 13 without the valve necessary to FIG. 17 is not enabled, and the Rollhaus patent is not an effective prior art reference.

In this context, the attention of the Office is drawn to a paper, copy attached, recently filed by the proprietors¹ of the cited Rollhaus patent, in defending their corresponding European Patent No. 0 925 581 against still earlier prior art. The record copy of this paper may be inspected on the European Patent Office image file wrapper system at www.epoline.org/portal/public.

In that filing, the proprietors contend (see paragraphs 2(e) and 2(f) on pages 7 and 8), that at the effective filing date of the Rollhaus patent it was "impossible" (page 7, line 11) to construct a laminated disc having a mobile liquid, within it, and that "the skilled man would not know how to do" that (page 7, lines 18-19, see also page 8, lines 7-8). The disclosure of the Rollhaus patent does not remedy the deficiencies of the earlier art, so by its proprietor's own admission the cited reference is insufficient, and the Rollhaus patent is not an effective prior art reference. *See* MPEP § 2121 and 2121.01 and cases cited therein. Further, absent any reason why the skilled person should have considered liquid surface phenomena as a

¹ An assignment of the US patent from SpectraDisc Corporation, the assignee shown on the face of the patent, to FlexPlay Technologies, Inc., the proprietor named in the attached paper, was Recorded on January 29, 2003 at Reel 013712, Frame 0860.

solution to the inadequacies of Rollhaus, the present claims would not have been obvious to a person of ordinary skill, even apart from the proprietor's admission that the person having ordinary skill would not have known how to construct such a disc.

For all of the above reasons, it is believed that independent claims 1 and 23 as now presented are both novel and non-obvious over the cited prior art. Independent claim 10 has been amended to incorporate previous claim 20, and it is believed that claim 10 as now presented is both novel and non-obvious over the cited prior art for the same reasons as claims 1 and 23.

Claims 2-7, 11-15, 18, 19, and 24-26 are dependent from claims 1, 10, and 23 and, without prejudice to their individual merits, are deemed to be novel and non-obvious for at least the same reasons as their respective base claims.

In addition, however, with respect to claims 3 and 13 the Office action cites to col. 3, lines 29-39 of Rollhaus, but that is a discussion of a different embodiment, using a reagent that is fixed in place and reacts with the atmosphere. Absent any disclosure of a single embodiment combining the features of col. 3, lines 29-39 and col. 11, lines 1-14, the 35 U.S.C. § 102 rejection is improper and should be withdrawn. Further, since the two embodiments are not merely different but mutually exclusive, it would not have been obvious to a person of ordinary skill to combine them, and claims 3 and 13 are not only novel but non-obvious.

Regarding claims 6, 11, and 25 the Office action in addressing claim 6 cites to the entire disclosure of the cited embodiment in the reference, without any indication of where any disclosure relevant to claim 6 may be found. The purported rejection of claim 6 is therefore traversed as contrary to 37 C.F.R. § 104(c)(2), second sentence, as failing to designate **as nearly as practical** the particular part of the reference relied on. In fact, Rollhaus is entirely silent as to whether the reservoir 72 is wholly filled or only partially filled as claimed in claims 6 and 11, and FIG. 13 clearly shows the outlet in the center of the reservoir, not at one end as claimed in claims 6 and 11. Regarding claim 25 only, the Office action further cites to the different embodiment of FIG. 17 (which is a radial cross section, so cannot assist the Office in this respect, and to "col. 1, lines 1-15," which is believed to be a typing mistake. The features of claims 6 and 11 provide a significant further improvement in the retention of the chemical agent by liquid surface phenomena, which is not only novel but also non-obvious over Rollhaus.

Regarding claim 19, the Office action identifies the structures 90' in FIG. 15 of Rollhaus as "an annular second reservoir to which a radially inner part of the data storage region is exposed." In fact, the structures 90' are openings, preferably located in the central portion of the disc **not** containing stored information (see col. 5, lines 62-65) that enhance the action of the galvanic cell, probably by admitting atmospheric oxygen or moisture for the purpose described at col. 4, line 65 to col. 5, line 3. Further, since the two embodiments combined in this rejection are not merely different but mutually exclusive, it would not have been obvious to a person of ordinary skill to combine them.

For these reasons also, at least claims 3, 6, 11, 13, 19, and 25 are deemed novel and non-obvious over the cited reference.

35 U.S.C. § 103 rejections:

Claims 16 and 17 are rejected as obvious over Rollhaus in view of U.S. Patent No. 5,768,221 (Kasimi). Claims 16 and 17 are dependent from claim 10, and Kasimi is relied on only in respect of the additional features of the dependent claims. Without prejudice to their individual merits, claims 16 and 17 are deemed to be novel and non-obvious over Rollhaus and Kasimi for at least the same reasons as claim 10 is novel and non-obvious over Rollhaus alone.

Claims 8, 9, 21, and 27 are rejected as obvious over Rollhaus. These claims are dependent from claims 1, 10, and 23, and the obviousness arguments are directed only to the additional features of the dependent claims. Without prejudice to their individual merits, claims 8, 9, 21, and 27 are deemed to be novel and non-obvious for at least the same reasons as their respective base claims.

In addition, however, it is respectfully pointed out that the proposed motivation "to reduce the size of the reservoir and maintain the size of the recording area" would not lead to the claimed result. First, reducing the size of the reservoir would reduce the volume of liquid, which would reduce the effectiveness of the device. This is especially true of applicant's embodiments where (see discussion of claims 6, 11, and 25 above) the reservoir is only partially filled. Maintaining an adequately large reservoir without encroaching on the recording area would suggest an **increase** in the narrowest dimension of the reservoir, which is of course the thickness (in the axial direction of the disc), and not the width (in the radial direction of the disc). The selected minimum dimension of the reservoir provides a

significant further improvement in the retention of the chemical agent by liquid surface phenomena, which is not only novel but also non-obvious over Rollhaus. For this reason also, claims 21 and 27 are believed to be non-obvious over the cited prior art.

The stated rejections of claims 6, 11, 21, 25, and 27 are further traversed as requiring the skilled person to act on irreconcilable motivations.

Claim 22 is rejected as obvious over Rollhaus in view of U.S. Patent No. 6,468,619 (Larroche). Claim 22 is dependent from claim 10, and Larroche is relied on only in respect of the additional features of the dependent claims. Without prejudice to its individual merits, claim 22 is deemed to be novel and non-obvious over Rollhaus and Larroche for at least the same reasons as claim 10 is novel and non-obvious over Rollhaus alone.

Conclusion:

In view of the foregoing, all of claims 1-19 and 21-27 are believed to be allowable. Applicant respectfully requests reconsideration of the examiner's rejections, and allowance of claims 1-19 and 21-27. An early notice of allowance is respectfully solicited. If the Examiner believes, however, that direct communication would advance prosecution, the Examiner is invited to telephone Henry Blanco White, telephone no. 215-988-3301.

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European Patent N° 0 925 581

Filed under N° : 97941598.1

in the name of FLEXPLAY TECHNOLOGIES INC.

"Machine readable optical disc with reading-inhibit agent"

Opposition filed by Patrick Larroche, FDD TECHNOLOGIES

Dear Sirs,

We refer to the above-mentioned matter.

Please note that FLEXPLAY TECHNOLOGIES INC (owner of the European patent N° 0 925 581) has appointed our Office as their representative in the opposition which was filed against their patent.

You will find enclosed our response to the Opposition Brief.

The powers of attorney will be sent to you later.

Very truly yours,

Didier INTES

Encls.

- Response to Opposition Brief
- Form 1037

Pierre BERBINAU



RESPONSE TO THE OPPOSITION NOTICE

Patent number: EP 0 925 581
Filing number: 97941598.1
Patentee: Flex Play Technologies Inc.
Title: Machine readable optical disc with reading-inhibit agent
Opponent: FDD / Patrick Larroche

In response to the opposition notice of December 15, 2006 against Claim 21, we hereby request:

1. The rejection of the opposition and maintenance of the patent as granted;
2. On a subsidiary basis, the set-up of oral proceedings.

I. Scope of the invention

The opposition is directed against claim 21 only.

The object of independent claim 21 of the opposed patent is an optical disc (CD, DVD, and the like) which comprises:

- information encoding features which are readable by a reading beam of an optical disc reading device;
- a reservoir included in the disc;
- a passageway interconnecting the reservoir and a portion of the disc comprising the information encoding features;
- a reading-inhibit agent included in the reservoir;
- wherein the reading-inhibit agent is activated by rotation of the disc.

The invention seeks to prevent the reading of the information on the disc after the disc has been read. More specifically the reading inhibiting agent passes out of the



reservoir toward the encoded information portion of the optical disc due to the effects of rotation of the disc so as to degrade the optical characteristics of the disc.

II. Grounds of opposition pursuant to Article 100(a) CBE

1. Interpretation of Claim 21

The text "a reservoir included in the disc" must be understood as "a reservoir contained in the disc". Indeed page 9, line 40 of the patent as granted specifies that the disc 100 is containing the reservoir 102.

2. Novelty of Claim 21 – Article 54(2) CBE

The opponent contends that the subject matter of claim 21 of the opposed patent is not new over the documents of Annex 1 (hereafter called document A1).

Document A1 discloses a device called DATA SECURE, which is a plastic indicator that is intended to be attached to an optical disc, and that comprises a reservoir containing a colored substance. The reservoir is elongated and shaped as a dumbbell, and initially the colored substance is located in one half of the dumbbell only. The indicator device is fixed near the center of the disc and arranged on the disc such that the colored substance is contained in the half of the dumbbell that is closer to the center of the disc. As the disc is read in a reading machine, it rotates, and the centrifugal force moves the colored substance radially toward the outside of the disc, into the half of the reservoir which was initially empty.

The intent of this indicator device is to determine whether the data on the disc is secure, i.e., no attempt has been made to read the information on the disc. In particular, if the colored substance has moved from the center of the disc within the plastic reservoir radially to the other half of the reservoir, the owner of the disc will know that someone has tried to read the information on that disc.

The object of Claim 21 is novel over document A1.

(a) • The opponent contends that document A1 discloses an optical disc in which a reservoir which contains a substance is included.



The opponent contends that because in document A1 the colored substance is perfectly contained in the reservoir of the "Data secure" device (page 2, column 2, paragraph 6), then the optical disc of document A1 has a reservoir. He also contends that because the indicator device is fixed firmly on the disc and cannot be displaced (by comparing the figures on page 1 showing that the indicator device does not move during reading), it can be described as "included" in the disc.

In fact the indicator device of document A1 is glued on the surface of the disc (page 3, column 1, paragraph 2: "...self-adhesive device..."). The indicator device is therefore not "Included" in the disc (the term "included in" having the meaning of "contained in", see II.1. above). Consequently the optical disc disclosed in document A1 does not include a reservoir containing a substance.

(b) • The opponent points to the narrow passageway connecting the two halves of the indicator device of document A1, and contends that this passageway connects the half of the reservoir initially containing the coloured substance and a portion of the disc comprising the information encoding features. The opponent also stresses that the two figures on page 1 prove that the substance has moved over a region overlapping the inner edge of the data area (page 5 of the Opposition Brief).

The Figures in document A1 only show that the outer part of the indicator device overlaps a region (in grey on the figures) which is at a distance from the center of the disc (the central region being shown in black). Since the text of document A1 states that the indicator device does not prevent data reading (page 2, column 1, paragraph 1), the only possible explanation is that the indicator device is glued on the label face of the disc (i.e., the face bearing no data), as acknowledged by the opponent (see the top of page 7 of the opposition brief). Therefore the passageway of the indicator device disclosed in document A1 does not connect the reservoir to a portion of the disc comprising the information encoding features.

Moreover, document A1 does not disclose a passageway interconnecting the reservoir and a portion of the disc comprising the information encoding features, as required by Claim 21. The self-adhesive indicator device of document A1 is placed on the disc (see reference above) and does not come into contact with an information encoding features.

(c) • Opponent contends that the term "reading-inhibit" agent should be construed broadly because the opposed patent EP 0925 580 provides various examples of such agents, and consequently that the colored substance of document

A1, which absorbs light at a certain range of frequencies, is such a reading-inhibit agent.

As mentioned above, the text of document A1 specifically states that the indicator device does not prevent data reading (page 2, column 1, paragraph 1: "*Data Secure does not prevent the reading or the copy of your disc by a malicious third party.*"). Consequently the colored substance of document A1 cannot be considered as being a "reading-inhibit" agent.

CONCLUSION:

Document A1 discloses neither an optical disc in which a reservoir is included, nor a reservoir connected to a portion of the disc comprising the information encoding features, nor a substance which is a reading-inhibit agent.

Therefore, the object of Claim 21 is novel with respect to document A1 pursuant to Article 54(2) EPC.

3. Inventive step of Claim 21 – Article 56 CBE

The object of Claim 21 is inventive with respect to document A1 in view of the documents of Annexes 2, 3, 4, 5, 7 (hereafter respectively called document A2, document A3, document A4, document A5, document A7), and the videos of Annex 6, pursuant to Article 56 EPC.

The opponent considers document A1 as the closest prior art, and applies the problem-solution approach to attempt to prove that Claim 21 is not inventive.

(a) • The opponent contends that the only technical difference between document A1 and claim 21 is the fact that the colored substance in document A1 could possibly not be considered as a reading-inhibit agent.

This assertion is however not correct, as we have shown above in II.2. There are many differences between document A1 and Claim 21. In fact, the only common features between the two are that the disc comprises information readable by a reading beam and that the reservoir contains an agent activated by rotation of the disc.



(b) • The opponent contends that document A1 is concerned with the same problem as the opposed Patent (page 4, item 5 of the Opposition Brief).

This assertion is also not correct. Document A1 is concerned with the deterrence, not the prevention of reading. This is stressed on page 2, column 1, paragraph 2 (*"In order to ensure a complete protection of data, it is advised to partition the data on several CD's"*). In document A1, no data is destroyed.

(c) • The opponent states that the objective technical problem of the invention over document A1, taken as the closest prior art, is how to modify the optical disc of document A1 to render the optical disc useless by the reading-inhibit agent (page 4, paragraph 5 of item 5 of the Opposition Brief). The opponent contends that the skilled man can put a chemically active reading-inhibit agent mentioned in document A2 into the reservoir of the indicator device of document A1. He claims that data reading will then be prevented by such a device because the outer part of the reservoir overlaps the data. He stresses that the combination of these two documents is obvious because they are from neighbouring technical fields and were published contemporaneously.

The outer part of the reservoir of the disc of document A1 does not overlap data, as explained in II.2 above. Since the reservoir is glued to the surface of the disc, it has an inner wall in contact with this surface, said inner wall forming a barrier that prevents the liquid contained in the reservoir to contact the disc. Therefore, even if a chemically active agent is put into the reservoir of the indicator device of document A1, which is not described in the document A1, this agent will not touch any portion of the disc, in particular the portion of the disc with data. Consequently even if documents A1 and A2 were combined as suggested by the opponent, such combination would not lead to the optical disc of Claim 21, and data reading would not be prevented. It would be necessary to radically modify the structure of the indicator device of document A1 for the agent to actually come in contact with a portion of the disc.

Furthermore, the skilled man would not be incited to combine document A1 and document A2, because document A1 is concerned with the deterrence of reading, not the destruction of data. Document A1 even points away from this solution by stressing that *"In order to ensure a complete protection of data, it is advised to partition the data on several CD's"* (see above). Besides, in document A2 there is no contact between the chemical agent and the data during the reading process (the chemical agent is put on the disc on purpose afterwards and while the disc is not in



the disc-player), and if the chemical agent was put in the reservoir of document A1, this agent would not touch the data (see above).

(d) • The opponent contends that in case Claim 21 is read as directed only to CD's which have a limited operating life, and not directed to CD's which are immediately disabled after reading, then the combination of document A3 with documents A1 and A2 would lead to Claim 21, and also that the combination of a "Mission Impossible" series video of Annex 6 with documents A1 and A2 would lead to the subject matter of Claim 21. The opponent claims that because document A3 discloses a writable IC card including a microprocessor that erases the rented information when the rental period expires, the skilled man would have the idea of using in the reservoir of document A1 a chemical substance similar to that of document A2 which destroys the data after a given time period. Similarly, the opponent claims that because Annex 6 discloses an optical disc which self-destruct after its first reading, the skilled man would have the idea of using in the reservoir of document A1 a chemical substance similar to that of document A2 which is delivered (onto the data) at the correct time, in response to the reading of the disc.

In document A3, the data is not destroyed or rendered inaccessible by using a chemical agent, but is reversibly erased (since data is stored on a RAM) by software. Consequently, a combination of these prior art references does not lead to the optical disc of Claim 21.

In the "Mission Impossible" series videos of Annex 6, it is not known how the disc is destroyed: it could very well be that the disc does not comprise any means of destruction, and that the destruction of the disc is solely due to some appropriate equipment in the disc-player playing the disc. Furthermore the disc-player itself is certainly damaged in the process. Therefore destruction of data through the use of a chemical substance with delayed-action is not disclosed by the combination of these documents/video. Consequently, a combination of these prior art references does not lead to the optical disc of Claim 21.

In addition, Claim 21 comprises an optical disc with a reservoir, a passageway interconnecting the reservoir to the information encoding features and a reading-inhibit agent. Claim 21 does not cover the general principles of self-destructing media as alleged by the opponent with respect to Annex 6. Such a principle may be known, but the particular implementation described in Claim 21 is not known, is not obvious and cannot be derived from reconstructing the features found in the alleged prior art.



Furthermore, the opponent combines three prior art references (documents A1 to A3, or documents A1 and A2 and the video of Annex 6) in his attempt to prove the lack of inventive step of Claim 21.

(e) • The opponent contends that in case it is argued that the indicator device of document A1 is glued on the disc (and especially on the label face of the disc), and is therefore not included in the disc, then document A4 or document A5 show that a fluid can be enclosed between layers of plastic within the disc, and spread outwardly when the disc is rotated. Therefore, the opponent claims that the skilled man would have the idea of placing the reservoir of document A1 in between layers of the disc, as hinted at in document A4 or document A5.

It is impossible to modify the indicator device of document A1 so that it can be placed inside the disc, because this implies placing the device during the manufacturing process of the disc. The opponent does not explain how to combine document A1 and document A4 or A5. It seems that he suggests making the disc of A1 in two halves and putting the colored substance in-between these two halves. It is then not clear how the two halves can be secured to each other (in other words, the disc cannot be properly manufactured). Securing these two halves would require putting both the colored substance and the adhesive in-between them, which the skilled man would not know how to do. And even if he does so, the colored substance will have already spread throughout the disc during its manufacturing, and so will not have any further effect during reading of the disc. In any case, it is necessary to stress that neither the adhesive nor the colored substance are reading inhibit agents, so the skilled man would be unable to achieve the device of Claim 21. Furthermore, document A4 is concerned with the spreading of an adhesive in between two halves of a disc (column 2, lines 1-15) during the manufacturing of the latter, and does not mention a reservoir. Document A5 is also concerned with the spreading of an adhesive in between two halves of a disc under centrifugal force (abstract) during its manufacturing and does not mention a reservoir. Consequently a combination of these documents does not lead to the optical disc of Claim 21. Besides, there is no incentive in document A1 to modify the structure of the disc, so the skilled man is not lead to combine either document A4 or document A5 with document A1.

(f) • The opponent contends that document A7 discloses a technique for forming an optical disc with an internal cavity, and claims that in combination with document A1 and either document A4 or document A5, the skilled man would design an optical



disc with a cavity containing a reading inhibit agent which could spread to data portions of the disc.

The purpose of the internal cavity of the optical disc of document A7 is to allow cooling of the disc through air circulation, and this internal cavity is open to the outside (column 2, lines 43-64). Consequently this cavity is not designed to contain a liquid, and cannot act as a reservoir. Therefore, there is no incentive for the skilled man to combine these documents. Even if he were attempting to do so, he would not know how to combine them to obtain the optical disc of Claim 21.

Furthermore, the opponent combines a minimum of three documents (documents A1, A4/A5, and A7) in his attempt to prove the lack of inventive step of Claim 21.

For these reasons, the object of Claim 21 is inventive with respect to any combination of the prior art references cited by the opponent, pursuant to Article 56 EPC.

(g) • As a general comment, we point out that none of the documents A3, A4, A5, and A7 are relevant to limiting the use of optical discs. Indeed, document A3 describes an integrated circuit card and does not relate to optical discs at all, documents A4 and A5 describe the manufacturing of conventional discs, and document A7 describes how to make a more reliable optical disc.

Furthermore, the whole discussion of the opponent on inventive step relies on a pure "ex-post facto" analysis. The opponent mentions several possible combinations of documents without indicating how such combinations could actually be made, and why the skilled man would have been incited to do so.

III. Conclusions

The object of Claim 21 of the opposed patent is novel and inventive, pursuant to Article 52(1) EPC.

The opposition must therefore be rejected (Article 102(2) EPC).

We trust that the Opposition Division agrees that the patent should be maintained in un-amended form in light of irrelevance of the art cited by the opponent. However,



in case the Opposition Division does not agree with the above conclusions, the set-up of oral proceedings is requested (Article 116(1)) as a precaution.